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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,539	07/24/2003	Toshihiro Ise	Q76566	8202

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EXAMINER	
YAMNITZKY, MARIE ROSE	
ART UNIT	**PAPER NUMBER**
1774	

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/625,539	ISE ET AL.	
	Examiner	Art Unit	
	Marie R. Yamnitzky	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10 and 12-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10 and 12-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. This Office action is in response to applicant's amendment filed June 17, 2005, which provides a new abstract, amends claims 1, 10 and 12-15, and cancels claim 11.

This Office action is also in response to the copy of the substitute declaration from the parent application, received June 17, 2005, and the terminal disclaimer filed June 17, 2005.

Claims 1-10 and 12-20 are pending.

2. The terminal disclaimer filed on June 17, 2005, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,440,586, has been reviewed and is accepted. The terminal disclaimer has been recorded.

3. The objection to the oath or declaration is overcome by the copy of the substitute declaration from the parent application.

The objection to the abstract, as set forth in the Office action mailed March 17, 2005, is overcome by the new abstract filed June 17, 2005.

All rejections of claim 11 are rendered moot by claim cancellation.

The rejection of claims 12 and 13 under 35 U.S.C. 112, 2nd paragraph, as set forth in the March 17th Office action, is overcome by the June 17th amendment.

The rejection of claims 10, 14, 18 and 19 under 35 U.S.C. 102(b) as anticipated by Denny et al. (US 5,968,933) is overcome by the June 17th amendment.

The rejection of claims 10, 12 and 18-20 under 35 U.S.C. 102(b) as anticipated by Krasovitskii et al. in *Zhurnal Vsesoyuznogo*... is overcome by the June 17th amendment.

The rejection of claims 10 and 18-20 under 35 U.S.C. 102(b) as anticipated by Krasovitskii et al. in *Khimiya Geterotsiklicheskikh*... is overcome by the June 17th amendment.

The rejection of claims 1, 2, 8 and 9 under 35 U.S.C. 102(e) as anticipated by Okada et al. (US 6,458,474 B1) is overcome by the June 17th amendment.

The rejection of claims 10, 12-15 and 18-20 under 35 U.S.C. 102(e) as anticipated by Yanagi et al. (US 6,440,586 B1) is overcome by the June 17th amendment, but the Yanagi patent is reapplied under 35 U.S.C. 103(a) against these claims.

The rejection of claims 1, 2 and 7-9 under 35 U.S.C. 102(e) as anticipated by Nii (US 6,537,687 B1) is overcome by the June 17th amendment.

The obviousness-type double patenting rejection set forth in the March 17th Office action is overcome by the terminal disclaimer filed June 17, 2005.

4. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites "alkylene", "arylene" and "divalent-heterocyclic group" as possibilities for L_1. Claim 15 recites "arylene" as a possibility for L_1. Claim 10, with claims 14 and 15 directly or ultimately dependent therefrom, defines L_1 as representing a "single bond, alkenylene, alkynylene or divalent aromatic heterocyclic group". Alkylene and arylene groups are not within the scope of L_1 as defined in claim 10, and not all divalent-heterocyclic groups are divalent-aromatic heterocyclic groups.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2 and 5-9 stand rejected under 35 U.S.C. 102(e) as being anticipated by Nii et al. (US 6,379,823 B1) for reasons of record in the Office action mailed March 17, 2005.

Claim 1 has been amended to recite the limitations also recited in original claim 5. Nii et al. disclose a compound meeting the limitations of original claim 5. As noted in the March 17th Office action, Nii's compound represented by formula 2-20 is a compound of present formula (IA) wherein L_1 represents a divalent heterocyclic group.

7. Claims 1-9 stand rejected under 35 U.S.C. 102(e) as being anticipated by Yanagi et al. (US 6,440,586 B1) for reasons of record in the Office action mailed March 17, 2005.

Claim 1 has been amended to recite the limitations also recited in original claim 5. Yanagi et al. disclose compounds meeting the limitations of original claim 5. As noted in the March 17th Office action, Yanagi's compounds represented by formulae A-3 and A-23-A-27 are examples of compounds of present formula (IA) wherein L_1 represents a divalent heterocyclic group.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 10 and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagi et al. (US 6,440,586 B1) for reasons of record with respect to claims 16 and 17 in the Office action mailed March 17, 2005 and the additional reasons set forth below.

Claim 10, with claims 12-20 dependent therefrom, has been amended to delete hydrogen as a possibility for R_{13}. Yanagi's compounds represented by formulae A-23-A27 meet the limitations of a compound of formula (IIA) as defined in amended claim 10 with the exception of the definition for R_{13}. Yanagi et al. do not provide any specific examples of compounds of present formula (IIA) where R_{13} represents an aliphatic hydrocarbon group, an aryl group or a heterocyclic group.

As noted in the March 17th Office action, Yanagi et al. disclose compounds having a benzimidazole group with hydrogen, an alkyl group or an aryl group at the position corresponding to present R_{13}. The examiner maintains the position that Yanagi's specific compounds would suggest to one of ordinary skill in the art at the time of the invention that the –NH– in the benzimidazole group of the compounds of formulae A-23-A-27 could be replaced with –NR– wherein R is an alkyl (a type of aliphatic hydrocarbon) or aryl group.

10. Applicant's arguments filed June 17, 2005 have been fully considered but they are not persuasive with respect to the rejection based on US 6,379,823 to Nii et al. or the rejections based on US 6,440,586 to Yanagi et al.

As noted above, both of the applied patents anticipate compounds of formula (IA) wherein L_1 is as defined in amended claim 1 and original claim 5.

With respect to the rejection of claim 10 and dependents, the examiner respectfully disagrees with applicant's argument that Yanagi et al. do not suggest the combination of definitions of R_{13} and L_1 in claim 10.

11. Applicant is advised that should claim 1 be found allowable, claim 5 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

All the limitations of original claim 5 have been incorporated into amended claim 1. Accordingly, claim 5 should be cancelled and claim 6 should be amended to depend from an appropriate claim other than claim 5.

12. Miscellaneous:

Claim 3 contains a spelling error not previously noticed by the examiner. In line 1, "emiting" should read --emitting--.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

MRY
August 10, 2005

Marie R. Yamnitzky

MARIE YAMNITZKY
PRIMARY EXAMINER
1774